

REMARKS

The Office Action dated March 5, 2008, has been received and carefully considered. Claims 1-30 are currently pending. Claims 1-30 are currently rejected. No claims have been amended. No new matter has been added. Reconsideration of the current rejections in the present application is also respectfully requested based on the following remarks.¹

I. THE ANTICIPATION REJECTION OF CLAIMS 1, 4-11, 15-19, 21-25, 29 AND 30

On page 2 of the Office Action, claims 1, 4-11, 15-19, 21-25, 29 and 30 were rejected under 35 U.S.C. § 102(e) as being anticipated by Callahan (U.S. Publication No. 2003/0229525). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re King, 801 F.2d 1324, 1326 (Fed. Cir. 1986). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Celeritas Tech., Ltd., v. Rockwell Int'l Corp., 150 F.3d 1354, 1361 (Fed. Cir. 1998). "In addition, the prior art reference must be enabling." Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985). Such possession is effected only if one of ordinary skill in the art

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions made by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant(s) that such assertions are accurate or such requirements have been met, and Applicant(s) reserve(s) the right to analyze and dispute such in the future.

could have combined the disclosure in the prior art reference with his/her own knowledge to make the claimed invention. Id..

Regarding claim 1, the Examiner asserts that Callahan discloses the claimed invention. Applicant respectfully disagrees. In particular, Applicant respectfully submits that Callahan fails to disclose, or even suggest, among other things, the following claim recitations of claim 1: “assessing an impact on the enterprise from a degradation of the services from the outside service provider,” and “automatically determining a criticality of the outside service provider in response to the assessment.”

In contrast, Callahan does not disclose any feature or functionality that even remotely comprises assessment of an outside service provider (“OSP”), much less the specific claimed steps of: “assessing an impact on the enterprise from a degradation of the services from the outside service provider,” and “automatically determining a criticality of the outside service provider in response to the assessment.”

Rather, as evidenced by the excerpt referenced by the Examiner, Callahan merely discloses a risk rating system that is based on the values of residual risk, probability of occurrence and an impact value, but does not teach or suggest any feature or functionality wherein an impact rating on an enterprise based upon degradation of the services of an OSP, or a criticality rating of an OSP:

If there is a "no" response, comments are required in a comment box. The comment area is available for any other explanatory matter. If the assessor provides a "Not Applicable" (N/A) response, additional information is also required and the response activity to that question then stops. The risk rating for the question is based on three, intermediate numerical values, residual risk, probability of occurrence, also called "threat value," and an impact value. Based on the answer to the question and the additional information provided, the assessor is asked to rate the residual risk of the threat posed by the question using a numerical value. Typically, the numerical threat value is provided by the designers of the questions, for example, by the information security organization,

and is a rating of the probability of occurrence for the threat posed by the question. An impact value evaluation is requested of the assessor. For example, if a customer's name and address were inadvertently revealed (which would be in violation of GLBA) the impact is less critical than if account balances, account numbers, and transactions were revealed. The system then takes the average of the three ratings to come to a risk rating for a question. Based on this rating, the assessor then determines whether current controls in place are sufficient or not. If not, remediation information is required. Based on the risk ratings for individual questions, an overall risk rating for the assessment can be determined.

See ¶ 60, Callahan.

Applicant respectfully submits that the mere mentioning of an impact value in the manner of Callahan does not teach or suggest each and every element of the pending claims, particularly the steps of “assessing an impact on the enterprise from a degradation of the services from the outside service provider,” and “automatically determining a criticality of the outside service provider in response to the assessment,” that are expressly set forth in claim 1. As stated in MPEP § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). Applicant respectfully submits that none of the other cited references make up for Callahan’s deficiencies in this regard.

Accordingly, it is respectfully submitted that claim 1 is allowable over Callahan and the other cited references.

Regarding claim 19, this claim recites subject matter related to claim 1. Thus, the arguments set forth above with respect to claim 1 are equally applicable to claim 19. Accordingly, it is respectfully submitted that claim 1 is allowable over Callahan and the other cited references for the same reasons as set forth above with respect to claim 1.

Regarding claims 2-18 and 20-30, these claims are dependent upon independent claim 1 or 19. Thus, since independent claims 1 and 19 should be allowable as discussed above, claims

2-18 and 20-30 should also be allowable at least by virtue of their dependency on independent claim 1 or 19. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination. For example, claim 2 recites the method of claim 1 further comprising identifying countries in which the outside service provider operates, and determining a country impact risk associated with the countries, wherein the step of automatically determining the criticality is also in response to the country impact risk. Applicant respectfully that none of the cited references -- alone or in combination teach or suggest the method of claim 1 further comprising the steps of identifying countries in which the outside service provider operates, and determining a country impact risk associated with the countries, wherein the step of automatically determining the criticality is also in response to the country impact risk.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1, 4-11, 15-19, 21-25, 29 and 30 be withdrawn.

II. THE OBVIOUSNESS REJECTION OF CLAIMS 2, 3, 12-14, 20 AND 26-28

On page 8 of the Office Action, claims 2, 3, 12-14, 20 and 26-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Callahan, in view of Bott (U.S. Patent No. 6,856,973), and further in view of Borgia (U.S. Publication No. 2002/0129221). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence,

or “secondary considerations,” of non-obviousness. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966); see also KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007). An “expansive and flexible approach” should be applied when determining obviousness based on a combination of prior art references. KSR, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. Id. at 1741. Rather, there must still be some “reason that would have prompted” a person of ordinary skill in the art to combine the elements in the specific way that he or she did. Id.; In re Icon Health & Fitness, Inc., 496 F.3d 1374, 1380 (Fed. Cir. 2007). Also, modification of a prior art reference may be obvious only if there exists a reason that would have prompted a person of ordinary skill to make the change. KSR, 127 S. Ct. at 1740-41.

Applicant respectfully submits that the obviousness rejections of claims 2, 3, 12-14, 20 and 26-28 are addressed by the comments set forth above in connection with the anticipation rejection of claims 1, 4-11, 15-19, 21-25, 29 and 30. In particular, Applicant respectfully submits that because independent claims 1 and 19 are allowable as set forth above, all dependent claims, including claims 2, 3, 12-14, 20, are also allowable.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 2, 3, 12-14, 20 and 26-28 be withdrawn.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

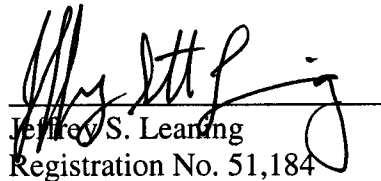
To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made. Specifically, a 1 month extension of time is requested.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

Hunton & Williams LLP

By:


Jeffrey S. Leaning
Registration No. 51,184

Hunton & Williams LLP
1900 K Street, N.W.
Washington, D.C. 20006-1109
Telephone: (202) 955-1500
Facsimile: (202) 778-2201

Date: 7/7/08